



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,780	07/28/2003	Kejun Fan	240961US0	4288
22850	7590	04/06/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KIM, YOUNG J	
			ART UNIT 1637	PAPER NUMBER
			NOTIFICATION DATE 04/06/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER

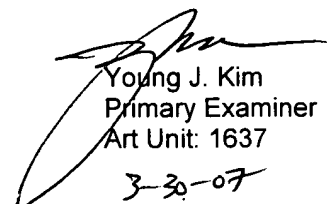
ART UNIT	PAPER
----------	-------

20070329

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents


Young J. Kim
Primary Examiner
Art Unit: 1637
3-30-07

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/627,780

Applicant(s)

FAN, KEJUN

Examiner

Young J. Kim

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-6 and 8-22.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

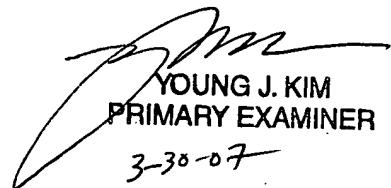
8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Young J. Kim
Primary Examiner
Art Unit: 1637

Continuation of 11. does NOT place the application in condition for allowance because: Preliminarily, Applicants' rebuttal based on the Evidence/Affidavit filed under Rule 132 are not addressed in view of Applicants' failure to comply with the provisions set forth in 37 CFR 1.116(e). The rejection of claims 1-6, 14, 15, and 17-22 under 35 U.S.C. 103(a) as being unpatentable over Dzieglewska et al. (of record) in view of Hayashizaki et al. (of record) made Final, in the Office Action mailed on November 9, 2006 is maintained for the reasons already of record. Applicants' arguments presented in the Amendment received on March 9, 2006 have been fully considered but they are not found persuasive for the following reasons. Applicants' arguments are addressed in the same order they were received. Applicants' interpretation of the disclosure of Hayashizaki et al. (on page 7, 1st paragraph, Response) is well taken. However, it is respectfully submitted that the examiner's interpretation of the disclosure is not the same as that of the Applicants'. Specifically, it is clearly stated in the disclosure of Hayashizaki et al., beginning on column 2, lines 61, that, "[a]t the step (a), a lysing solution, COMPRISING a DNA containing biological sample, a salt and a cationic surfactant, and having a salt concentration the same or higher than the precipitation inhibition-initiating concentration is PUT INTO CONTACT with a DNA-binding carrier to allow the DNA comprised in the biological sample to bind to the DNA-binding carrier." What is clear from this disclosure is that the lysis solution which already comprises the DNA containing biological sample is contacted with the DNA-binding carrier. Hence, a lysis solution which already comprises the so called, DNA containing biological sample, must have lysed the cells so as to released the DNA molecules therein, so that when it is brought into contact with the DNA-binding carrier, said DNA molecules can be bound. Applicants' appear to read more into the disclosure than what is actually disclosed in the prior art, that is, Applicants argue that the disclosure of Hayashizaki et al. emphasize the advantage of their invention as not requiring manipulation steps (e.g., centrifugation) between the lysing and binding because they are accomplished at the same time (page 7, 2nd paragraph, Response). It is respectfully submitted that the disclosure of Hayashizaki et al. never recites that the lysing and the binding occur at the, "same" time. If Applicants can find such a recitation from Hayashizaki et al.'s disclosure, Applicants are invited to point out where, exactly, the purported statement can be found. Contrary to Applicants' position, what is absolutely clear from Hayashizaki et al.'s disclosure is in that there is no separate purification step between the providing of the lysing solution (which contains the samples containing DNA) and the contacting of said lysing solution with DNA-binding carriers. To reiterate, the disclosure of Hayashizaki et al. is explicit in stating that the lysing solution which already comprises a sample containing DNA molecules is brought into contact with the DNA-binding carriers. Sine preparing such a solution would have resulted in the lysis of the cells containing the DNA molecules, the subsequent contacting step (with DNA-binding carriers) would clearly meet all of the limitations to which Applicants' contend otherwise. With regard to Applicants' arguments drawn to why the present invention provides numerous advantages for real-world applications, it is respectfully submitted that the comparison is not with respect to the teachings of the combination of the reference, but rather the traditional means of DNA purification/isolation (i.e., phenol/chloroform extraction), which is clearly not employed by Dzieglewska et al. nor Hayashizaki et al. Hence, such argument is irrelevant and non-convincing. Applicants' arguments based on their evidence/affidavit filed under Rule 132 will be considered upon Applicants' fulfillment of Rule 1.116(e) or upon filing of an RCE. The rejection of claims 8-12 under 35 U.S.C. 103(a) as being unpatentable over Dzieglewska et al. (of record) in view of Hayashizaki et al. (of record), as applied to claims 1-6, 14, 15, and 17-22 above, and further in view of Ekeze et al. (of record), made Final, in the Office Action mailed on November 9, 2006 is maintained for the reasons already of record. Applicants do not present any new arguments for the instant rejection, but relies on their previous arguments which had been fully addressed above. Hence, the rejection is maintained for the reasons of record. The rejection of claims 13 and 16 under 35 U.S.C. 103(a) as being unpatentable over Dzieglewska et al. (of record) in view of Hayashizaki et al. (of record), as applied to claims 1-6, 14, 15, and 17-22 above, and further in view of Belley et al. (of record), made Final, in the Office Action mailed on November 9, 2006 is maintained for the reasons already of record. Applicants do not present any new arguments for the instant rejection, but relies on their previous arguments which had been fully addressed above. Hence, the rejection is maintained for the reasons of record.


YOUNG J. KIM
PRIMARY EXAMINER
3-30-07